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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,100	01/12/2001	W. David Shambroom	96-3-512CON1CIP2	1842

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EXAMINER

ABRISHAMKAR, KAVEH

ART UNIT PAPER NUMBER

2131

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,100

Applicant(s)

SHAMBROOM

Examiner

Kaveh Abrishamkar

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the communication filed on January 12, 2001. Claims 1 – 36 were originally received for consideration. No preliminary amendments for the claims were filed. Claims 1 – 36 are currently under consideration.

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 2, is attached to the Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 recites the limitation "establishing step (a)" in the first line. However, there is not establishing step in step (a), only a method for obtaining credentials for authorizing the principal from a validation center. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 4, 6, 15- 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 27 of U.S. Patent No. 5,923,756 in view of Fischer (U.S. Patent No. 5,005,200).

Regarding independent claims 1, 23, and 36,

Claim 1 of U.S. Patent No. 5,923,756 recites a method of enhancing the security of a message sent through a network server from a client computer to a destination server. The method of claim 1 differs from claims 1 and 23 of the instant application in that it does not explicitly disclose verifying the authorization of the principal in the

network server to access a digital certificate and issuing a digital certificate to the network server.

However, Fischer, in an analogous environment, discloses a trusted authority creating and issuing a digital certificate to a claimant (network server), which reveals the public key of the user, which will be used to establish a secure connection (SSL) (column 3 line 53 – column 4 line 27). U.S. Patent No. 5,923,756 discloses in claim 14 “authenticating that the party transmitting the message to said destination server is the same party that was certified using the authentication protocol by the key distribution center to receive said access indicator.” The “authenticating” step does not explicitly state via a digital certificate, but digital certificates were well known in the art at the time the Applicant’s invention was made as disclosed by Fischer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the Applicant’s invention was made to incorporate the teachings of Fischer into the system of U.S. Patent No. 5,923,756 to provide a method of verifying the authorization of the principal in the network server to access a digital certificate and issuing a digital certificate to the network server before establishing a secure connection. This modification would have been obvious because one of ordinary skill in the art would want to use a digital certificate to not only provide non-repudiation between the network server and the destination server, but also, to provide the public key that will be used in future secure communications simultaneously to conserve network resources while increasing the overall security of the network.

Claims 2 – 6, 15 – 22, 24 – 35 of the instant application contain the limitations of independent claims rejected above, and are only distinguishable from claims 1 – 27 of U.S. Patent No. 5,923,756 by virtue of the limitations of the independent claims from which they depend. Therefore, claims 2 – 6, 15 – 22, 24 – 35 of the instant application are rejected as applied above in rejecting independent claims 1, 23, and 36 in combination with claims 1 – 27 of U.S. Patent No. 5,923,756.

5. Claims 7 - 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 27 of U.S. Patent No. 5,923,756 in view of Fischer (U.S. Patent No. 5,005,200) in further in view of Krajewski, Jr. et al. (U.S. Patent 5,590,199).

Claim 6 of U.S. Patent No. 5,923,756 recites a method of generating a credentials cache using client-authenticating information obtained using a Kerberos protocol. The method of 6 differs from claims 7 - 14 of the instant application in that it does not explicitly disclose the individual steps involved in the Kerberos protocol.

However, Krajewski, in an analogous environment, discloses a detailed description of the Kerberos protocol. Krajewski discloses that a principal-authenticating credential comprises a ticket-granting ticket and a session key (Figure 5), transmitting a ticket-granting ticket and an authenticator (column 5 lines 25 – 39), a ticket-granting ticket which comprises a session key encrypted with a permanent key (column 5 lines 14 – 24), an authenticator which is a data structure encrypted using a session key

(column 5 lines 25 – 33), creating a server ticket at the validation center (Figure 6) and receiving the server ticket at the network server (Figure 7). Though U.S. Patent No. 5,923,756 does not explicitly delineate all the steps involved in the Kerberos authentication, it was well-known in the art at the time the applicant's invention was made that the steps delineated by Krajewski are implicitly implied by the Kerberos protocol. Therefore it would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to incorporate the steps of the Kerberos protocol delineated by Krajewski into the combination of U.S. Patent 5,923,756 and Fischer so that client can authenticate to the network server.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 703-305-8892. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2131

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KA
09/06/2004


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